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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,145	05/03/2006	Teruki Hayashida	52433/846	8822
26646 7590 10/28/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
FOGARTY, CAITLIN ANNE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,145

Applicant(s)

HAYASHIDA ET AL.

Examiner

CAITLIN FOGARTY

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-8 is/are pending in the application.
4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 7, 8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 2, and 4 – 8 are pending where claims 1, 2, and 5 have been amended and claims 7 and 8 are new. Claims 4 - 6 are withdrawn as a result of a restriction requirement and claim 3 has been cancelled.

Status of Previous Rejections

2. The 35 U.S.C. 103(a) rejection of claims 1 and 2 as being unpatentable over Matsuoka et al. (US 2003/0111144) has been maintained. The rejection of claim 3 is moot since claim 3 has been cancelled.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuoka et al. (US 2003/0111144).

Matsuoka is applied to instant claims 1 and 2 as discussed in the 3/3/2008 Office action.

With respect to the amended features of instant claims 1 and 2, Matsuoka does not specifically teach that the hot-rolled steel sheet is free from bald spots or the roughness and the number and size of pittings of the steel sheet. However, since the steel sheet of Matsuoka has an overlapping composition and a process of making similar to that of the instant invention, it would be expected that the steel sheet of Matsuoka would be free from bald spots and would have

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the recited roughness and number and size of pittings. See MPEP 2112 III and IV.

Instant claims 7 and 8 are product-by-process claims and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. In the absence of factual evidence that the process limitation would impact the product, only the structure implied by the process limitations of claims 7 and 8 will be considered. As discussed in the 3/3/2008 Office action regarding instant claims 1 and 2, Matsuoka teaches a hot rolled steel sheet with an overlapping composition. Matsuoka differs from instant claims 7 and 8 because it does not specifically teach that the hot-rolled steel sheet is free from bald spots. However, since the steel sheet of Matsuoka has an overlapping composition and a process of making similar to that of the instant invention, it would be expected that the steel sheet of Matsuoka would be free from bald spots. See MPEP 2112 III and IV.

Response to Arguments

5. Applicant's arguments filed July 7, 2008 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

- a. US '144 does not disclose or suggest anything specific about chemical conversion treatment of the hot rolled steel plate such as what type of chemical conversion treatment is applied or how to apply the chemical conversion treatment. The treatment of US '144 does not belong to the type of acid pickling of the hot rolled steel plate because US '144 discloses that this treatment must be carried out after annealing or galvanizing.
- b. The method of pickling taught by US '144 is not the same as the pickling of the hot rolled steel sheet according to the method of the instant invention.
- c. There is no disclosure in US '144 about pickling and chemical conversion treatment after temper rolling.
- d. US '144 does not teach or suggest that acid pickling is applied to the surface of the hot rolled steel sheet and then chemical conversion treatment is applied. US '144 also does not disclose how to pickle the steel sheet which assumes a conventional pickling method.
- e. US '144 does not disclose or suggest the pickling of the present invention which is required to obtain the hot rolled steel sheet excellent in chemical convertibility free from bald spots and which has the surface roughness and pittings as defined in amended independent claims 1 and 2.

Examiner's responses are as follows:

a. The product claims of the instant application were elected and examined. Therefore, the type of chemical conversion treatment or how to apply the chemical conversion treatment is not relevant to the instant claims since it is not a claim limitation in the product claims. Additionally, the instant claims do not recite when the pickling treatment of the steel must take place. Furthermore, [0151]-[0152] of US '144 teaches that after annealing or a surface treatment such as galvanizing, the hot-rolled steel sheet of the invention may be subjected to a special treatment to improve chemical conversion treatment property. Therefore, the hot rolled steel sheet of US '144 satisfies the instant claim limitation that the steel sheet is excellent in chemical convertibility.

b. US '144 is not required to teach the same pickling method as that of the instant invention as long as the final product is the same since only the product claims were elected. The Examiner asserts, in the absence of factual evidence, that the hot rolled steel sheet of US '144 would be expected to have the same properties as that of the instant invention since the steel sheet of US '144 has an overlapping composition and a process of making similar to that of the instant invention.

c. – e. Instant claims 7 and 8 are product-by-process claims and even though they are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113.

Therefore, US '144 is not required to teach pickling and chemical

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conversion after temper rolling. In addition US '144 is not required to teach that acid pickling is applied to the surface of the hot rolled steel sheet and then chemical conversion treatment is applied. Since the elected claims are product claims and not process claims the Examiner asserts, in the absence of factual evidence, that the hot rolled steel sheet of US '144 would be expected to have the same properties as that of the instant invention since the steel sheet of US '144 has an overlapping composition and a process of making similar to that of the instant invention. In addition, see the 35 U.S.C. 103(a) rejection above. Furthermore, the Examiner notes Applicant's argument comparing data from the "Handbook of Iron and Steel" from 1980. However, any unexpected results must be in declaration form.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

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